

## **REMARKS**

### **I. Introduction**

With the cancellation herein without prejudice of claims 17 to 18, claims 13 to 16, and 19 to 26 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the acknowledgment that all certified copies of the priority documents have been received.

### **II. Objection to Claims 14 to 17, 19, and 23 to 25**

Claims 14 to 17, 19, and 23 to 25 were objected to for informalities. As an initial matter, claim 17 has been canceled herein without prejudice, thereby rendering moot the present objection with respect to claim 17. Accordingly, claims 14 to 16, 19, and 23 to 25 have been amended herein without prejudice, thereby obviating the present objection. No new matter has been added, and the claims are supported by the present application. Withdrawal of this objection is therefore respectfully requested.

### **III. Rejection of Claims 13, 14, 16, and 19 to 25 Under 35 U.S.C. § 102(b)**

Claims 13, 14, 16, and 19 to 25 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,294,679 ("Maurer et al."). It is respectfully submitted that Maurer et al. do not anticipate the present claims for at least the following reasons.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

Claim 13, as presented, relates to a sensor element for detecting a physical property of one of a gas and a liquid, including, *inter alia*, a first layer, a second layer, and at least one contact face. Claim 13 recites that the first layer includes a recess in a region of the at least one contact face. Claim 13 further recites that the recess has a slotlike-shaped recess that widens toward an outer face of the sensor element.

Maurer et al. do not identically disclose, or even suggest, the feature that the recess has a slotlike-shaped recess that widens toward an outer face of the sensor element. Indeed, the Office Action at page 8 admits that "Maurer fails to disclose the recess of the sensor element has a slotlike-shaped recess."

Accordingly, Maurer et al. do not identically disclose, or even suggest, all of the features included in claim 13, as presented. As such, it is respectfully submitted that Maurer et al. do not anticipate claim 13.

As for claims 14, 16, and 19 to 25, which ultimately depend from claim 13 and therefore include all of the features included in claim 13, it is respectfully submitted that Maurer et al. do not anticipate these dependent claims for at least the same reasons more fully set forth above.

In view of all the foregoing, withdrawal of this rejection is respectfully requested.

#### **IV. Rejection of Claims 13, 16, 19, 21, 23, and 24 Under 35 U.S.C. § 102(b)**

Claims 13, 16, 19, 21, 23, and 24 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,110,442 ("Kojima et al."). It is respectfully submitted that Kojima et al. do not anticipate the present claims for at least the following reasons.

Kojima et al. do not identically disclose, or even suggest, the feature that the recess has a slotlike-shaped recess that widens toward an outer face of the sensor element. Indeed, nowhere do Kojima et al. disclose a slotlike-shaped recess.

Accordingly, Kojima et al. do not identically disclose, or even suggest, all of the features included in claim 13, as presented. As such, it is respectfully submitted that Kojima et al. do not anticipate claim 13.

As for claims 16, 19, 21, 23, and 24, which ultimately depend from claim 13 and therefore include all of the features included in claim 13, it is

respectfully submitted that Kojima et al. do not anticipate these dependent claims for at least the same reasons more fully set forth above.

In view of all the foregoing, withdrawal of this rejection is respectfully requested.

**V. Rejection of Claim 15 Under 35 U.S.C. § 103(a)**

Claim 15 was rejected under 35 U.S.C. § 103(a) as unpatentable over Maurer et al. It is respectfully submitted that Maurer et al. do not render unpatentable the present claim for at least the following reasons.

Claim 15 depends from claim 13, as presented. As more fully set forth above, Maurer et al. do not disclose, or even suggest, the feature that the recess has a slotlike-shaped recess that widens toward an outer face of the sensor element, as provided for in the context of claim 13, as presented.

Accordingly, it is respectfully submitted that Maurer et al. do not disclose, or even suggest, all of the features included in claim 13, from which claim 15 depends. As such, it is respectfully submitted that Maurer et al. do not render unpatentable claim 15, which depends from claim 13.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**VI. Rejection of Claim 17 Under 35 U.S.C. § 103(a)**

Claim 17 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Maurer et al. and U.S. Patent No. 4,334,974 ("Muller et al.").

Claim 17 has been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claim 17.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**VII. Rejection of Claim 18 Under 35 U.S.C. § 103(a)**

Claim 18 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Maurer et al., Muller et al., and U.S. Patent Application Publication No. 2002/0164897 ("Liang"). Claim 18 has been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claim 18. Nonetheless, since claim 13 has been amended herein without prejudice to include

the features of canceled claim 18, the present rejection will be addressed with respect to claim 13, as presented. It is respectfully submitted that the combination of Maurer et al., Muller et al., and Liang does not render unpatentable the presently pending claim for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), the prior art must teach or suggest each element of the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). In addition, as clearly indicated by the Supreme Court, it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. See KSR Int'l Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007). Further, the Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. M.P.E.P. §2143.

As more fully set forth above, and as admitted in the Office Action at page 9, "Maurer and Muller fail to disclose the slotlike-shaped recess widens toward the outer face of the sensor element." Further, Liang also does not disclose, or even suggest, the feature that the recess has a slotlike-shaped recess that widens toward an outer face of the sensor element, and thus, also fails to cure this critical deficiency. Liang merely indicates a terminal connector with a Y-shaped opening and a slot, which pierces the outer insulation layer of an inserted wire. Liang, ¶ 21. However, Liang nowhere discloses a sensor element including, inter alia, a first layer, a second layer, and at least one contact face, the first layer including a recess having a slotlike-shaped recess that widens toward an outer face of the sensor element.

Further, as set forth in the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.," 72 Fed. Reg. 57526 (October 10, 2007), the key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of reasons why the claimed subject matter would have been obvious, and rejections for obviousness cannot be sustained by mere conclusory statements. Rather, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. Among the rationales enumerated in the Guidelines are: (a) combining prior art elements according to known methods to yield predictable

results; (b) simple substitution of one known element for another to obtain predictable results; (c) use of known technique to improve similar devices (methods, or products) in the same way; (d) applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (e) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (f) known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; and (g) some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

The Office Action refers to some teaching, suggestion, or motivation to modify or combine, and states that "one with ordinary skill in the art would have been motivated [to] modify the slot opening of Muller with a Y-shaped opening like that of Liang because the Y-shaped opening would guide the contacts to the conductive strip of the sensing electrode." Office Action, p. 9. However, it is respectfully submitted that that type of conclusory statement is insufficient to establish unpatentability under 35 U.S.C. § 103(a).

The M.P.E.P. states that "[t]o reject a claim based on this rationale [of some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention], . . . Office personnel must articulate the following: (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) a finding that there was reasonable expectation of success; and (3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness." (M.P.E.P. § 2143 (emphasis added)).

It is respectfully submitted that the Office Action has not articulated at least (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, or (2) a

finding that there was reasonable expectation of success, as is required by the M.P.E.P.

Accordingly, it is respectfully submitted that the combination of Maurer et al., Muller et al., and Liang does not disclose, or even suggest, all of the features included in claim 13, as presented. Therefore, it is respectfully submitted that the combination of Maurer et al., Muller et al., and Liang does not render unpatentable the presently pending claim for at least the foregoing reasons.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**VIII. Rejection of Claim 26 Under 35 U.S.C. § 103(a)**

Claim 26 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Maurer et al. and Kojima et al. It is respectfully submitted that the combination of Maurer et al. and Kojima et al. does not render unpatentable the present claim for at least the following reasons.

Claim 26, as presented, includes features analogous to claim 13, as presented. As more fully set forth above, Maurer et al. and Kojima et al. do not disclose, or even suggest, the feature that the recess is formed as a slotlike-shaped recess that widens toward an outer face of the sensor element.

Accordingly, it is respectfully submitted that the combination of Maurer et al. and Kojima et al. does not disclose, or even suggest, all of the features included in claim 26, as presented. As such, it is respectfully submitted that the combination of Maurer et al. and Kojima et al. does not render unpatentable claim 26.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**IX. Rejection of Claim 26 Under 35 U.S.C. § 103(a)**

Claim 26 was rejected under 35 U.S.C. § 103(a) as unpatentable over Kojima et al. It is respectfully submitted that Kojima et al. does not render unpatentable the present claim for at least the following reasons.

As more fully set forth above, Kojima et al. do not disclose, or even suggest, the feature that the recess is formed as a slotlike-shaped recess that widens toward an outer face of the sensor element.

Accordingly, it is respectfully submitted that Kojima et al. do not disclose, or even suggest, all of the features included in claim 26, as presented. As such, it is respectfully submitted that Kojima et al. do not render unpatentable claim 26.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**X. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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